

REMARKS

SUMMARY

Claims 1-48 are pending.

Claims 1-48 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Ghouri, U.S. Patent Publication No. 20040162835 ("Ghouri"), further in view of Mohapatra et al., U.S. Patent Publication No. 20060149416 ("Mohapatra").

APPLICANTS' RESPONSE

In this Response, Applicants present arguments concerning the patentability of claims 1-48 to address the Examiner's rejections. Applicants' silence with regard to any aspect of the Examiner's rejections of the dependent claims constitutes recognition by the Applicants that the rejections are moot based on Applicants' remarks relative to the independent claim from which the dependent claims depend.

Applicants have amended claims 34-48 to better clarify the claimed subject matter. No new matter is introduced by virtue of these amendments.

35 U.S.C. § 103 REJECTIONS

To reject claims in an application under Section 103, the Office Action must establish a *prima facie* case of obviousness. Using the Supreme Court's guidelines enunciated in *Graham v. John Deere*, 383 U.S. 1, 17 (1966), one determines "obviousness" as follows: Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

In *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), the Supreme Court reaffirmed the *Graham* test, and indicated that although it should not be rigidly applied, a helpful insight into determining obviousness is to consider whether there is a teaching, suggestion or motivation in the prior art that would lead one of ordinary skill in the art to combine known elements of the prior art to arrive at the claimed invention. The Court emphasized that a patent examiner's analysis under Section 103 should be made explicit in order to facilitate review.

Thus, to establish a *prima facie* case of obviousness, the Office Action must construe the scope of the prior art, identify the differences between the claims and the prior art, and determine the level of skill in the pertinent art at the time of the invention. The Office Action must then provide an explicit, cogent reason based on the foregoing why it would be obvious to modify the prior art to arrive at the claimed invention. Applicants respectfully submit that cited prior art, whether taken alone or in combination, does not disclose or suggest each and every feature of independent claims 1, 17, and 33.

Claim 1

Applicants respectfully submit that neither *Ghouri* nor *Mohapatra*, taken alone or in combination, discloses or suggests the subject matter of claim 1. At the outset,

The currently claimed subject matter relates to categorizing a product as a branded product or a generic product. a product originator indicator, patent status indicator, source indicator, and tradename indicator are determined. Once the originator, patent status, source, and tradename have been determined, the product is then categorized as a brand or generic product based on the foregoing determinations. For example, Table I (reproduced below) from the specification provides some example categorizations where a product is determined to be a brand name product.

Secondary Level

Primary Level	Originator	Patent Status	Source	Tradename
Brand Name	Originator	On-patent	Single-source	Tradename
	Originator	On-patent	Multi-source	Tradename
	Originator	On-patent	Co-Licensed	Tradename
	Originator	On-patent	Single-source	Non-Tradename
	Originator	On-patent	Multi-source	Non-Tradename
	Originator	On-patent	Co-Licensed	Non-Tradename
	Originator	Off-patent	Single-source	Tradename
	Originator	Off-patent	Multi-source	Tradename
	Originator	Off-patent	Co-Licensed	Tradename
	Originator	Off-patent	Single-source	Non-Tradename
	Originator	Off-patent	Multi-source	Non-Tradename
	Originator	Off-patent	Co-Licensed	Non-Tradename
	Non-Originator	On-patent	Single-source	Tradename
	Non-Originator	On-patent	Multi-source	Tradename
	Non-Originator	On-patent	Co-Licensed	Tradename
	Non-Originator	On-patent	Single-source	Non-Tradename
	Non-Originator	On-patent	Multi-source	Non-Tradename
	Non-Originator	On-patent	Co-Licensed	Non-Tradename

The Office Action argues that *Ghouri* discloses determining an originator indicator, patent status, source, and tradename indicator. However, Applicants respectfully submit that *Ghouri* does not disclose or suggest these features. *Ghouri*, rather than determining originator, patent status, source, and tradename indices for a given pharmaceutical product, normalizes a given product (identified by tradename or chemical name) into an identifying index. “Since medications are often identified by multiple names, e.g., different trade names and a generic name, the medication input data is normalized to account for various differing identifying names for the same medication. Normalization is the terminology used to describe the accounting process which takes place upon data entry of any one of an item's trade names, chemical description or generic name.” *Ghouri*, Para. [0087]. At best, *Ghouri* merely mentions a product’s tradename or chemical name (as input) but does not, given a product, determine any of the four indicators above. Accordingly, nothing in *Ghouri* discloses or suggests the recited

features of claim 1. Likewise, nothing in *Mohapatra* discloses or suggests the foregoing features.

In addition, the Office Action concedes that *Ghouri* does not disclose categorization of a product as brand name or generic. The Office Action argues that *Mohapatra* discloses this feature. However, Applicants respectfully disagree. Claim 1 recites, *inter alia*, “categorizing the product as a branded product or a generic product, using said originator indicator, said patent status indicator, said source indicator, and said tradename indicator.”

The data regarding medications in *Mohapatra* “contain information about generic/brand name” but *Mohapatra* does not disclose or suggest categorizing medications as brand name or generic as recited in claim 1. *Mohapatra*, Para. [0093]. *Mohapatra* recites, “[m]ultiple ingredient IV orders, TPN's and compound medications generally require such selection of multiple formulary items. The formulary item selection can be by generic name, drug description, brand name, mnemonic key, agent.” *Mohapatra*, Para. [0104]. *Mohapatra* merely includes brand name or generic as merely an aspect of the formulary item rather than categorizing formulary items into a generic or brand name category.

Nevertheless, even assuming arrguendo that *Mohapatra* discloses or suggests categorizing a product as a brand name or generic, *Mohapatra* does not disclose or suggest categorizing the product “using said originator indicator, said patent status indicator, said source indicator, and said tradename indicator” as recited in claim 1. In fact, *Mohapatra* does not disclose any of the foregoing indicators. Accordingly, neither *Mohapatra* nor *Ghouri*, taken alone or in combination, do not disclose or suggest this feature of claim 1. Applicants therefore request withdrawal of the rejection to claim 1.

Claims 17 and 33

Independent claims 17 and 33 include similar features as claim 1. Accordingly, Applicants respectfully request withdrawal of the rejections to claims 17 and 33 for at least the same reasons as claim 1.

Claims 2-16, 28-32, and 34-48

Claims 2-16, 18-32, and 34-48 depend from claims 1, 17, and 33, respectively. Applicants therefore request withdrawal of the rejections to these claims at least because of their dependence from the independent claim from which they depend.

CONCLUSION

Applicants respectfully submit that this application is now in condition for allowance.

Reconsideration and prompt allowance of which are respectfully requested.

The Examiner is invited to contact the undersigned at (212) 408-2517 if any additional information or assistance is required.

Applicants believe that no additional fee is due in connection with the filing of this response other than the fee for the three month extension. If any additional fee is due, or overpayment made, with regard to this response, Applicants authorize the Director to charge any such fee, and credit any overpayment, to Deposit Account No. 02-4377.

Respectfully submitted,

BAKER BOTTS L.L.P.



Paul Ragusa
Patent Office Reg. No. 38,587

Jack L. Chen
Patent Office Reg. No. 48,634

30 Rockefeller Plaza
44th Floor
New York, NY 10012-4498
Attorney for Applicant(s)
212-408-2500

March 2, 2010

Date